

**REMARKS**

Claims 1-48 were pending in this application. Claims 1-48 have been deleted without prejudice to Applicants' right to prosecute the subject matter of these claims in one or more related continuation, continuation-in-part and/or divisional applications. New claims 49-52 have been added to more particularly point out what Applicants consider as the invention. Support for the new claims 49-52 can be found in the specification of the instant application as well as in the earliest priority application, application serial no.: 08/316,439, now U.S. Patent 5,840,520, *e.g.*, as set forth in the chart below. Thus, the new claims do not introduce new matter. Claims 49-52 will be pending upon entry of the present amendment.

<u>Claim</u>	<u>Specification</u> (application serial no.: 08/316,439, now U.S. 5,840,520)	<u>Specification</u> (instant application)
49	Column 44, lines 19-32	Page 34, lines 13-22
50-52	Column 44, lines 29-32	Page 34, lines 18-22
53	Column 24, lines 28-56	Page 30, lines 7-8

**COMPLIANCE WITH RULES FOR CLAIM TO PRIORITY**

Applicants' request to amend priority of the present application to receive the benefit of an earlier filing date under 35 U.S.C. § 120 has not been granted because the present application does not share an inventor with U.S. Application No. 08/316,439. Applicants assert that the names of inventors Dr. Clarke and Dr. Palese were inadvertently omitted from the present application. A Request To Correct Inventorship is being filed concurrently herewith. Thus, Applicants assert that continuity of inventorship has been restored. Applicants' request for receiving the benefit of an earlier filing date should therefore be granted.

A Request To Correct Inventorship under 37 C.F.R. § 1.48(a) is being filed concurrently herewith under separate transmittal to add Dr. Peter Palese and Dr. David Clarke as inventors to the present application. Further, as required by 37 C.F.R. § 1.48(a), a Consent by Assignee as well as a newly executed Declaration for Non-Provisional Patent Application are also filed herewith. Upon entry of the present amendment to inventorship, the present application and U.S. Application No. 08/316,439 share Dr. Peter Palese and Dr. David Clarke as inventors. Therefore, the requirement of continuity of inventorship is met and the earliest date of priority of the present application is September 30, 1994.

**THE OBJECTION TO THE SPECIFICATION SHOULD BE WITHDRAWN**

The incorporation by reference of prior application 08/316,439 was objected under 35 U.S.C. § 132 allegedly for introducing new matter into the disclosure of the present application. In response applicants have amended the claim to priority to delete the incorporation by reference of prior application 08/316,439. Thus, the objection to the specification should be withdrawn.

**THE REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, SHOULD BE WITHDRAWN**

Applicants acknowledge that the rejections of claims 18, 22-32 and 35 under 35 U.S.C. § 112, first paragraph, were withdrawn. The rejections of claims 17 and 36-40 under 35 U.S.C. § 112, first paragraph, were maintained allegedly for failing to recite any attenuating feature of the RSV.

In view of the cancellation of claims 1-48, the rejection of claims 17 and 36-40 is moot. Applicants further assert that the rejection of claims 17 and 36-40 does not apply to new claim 49 as new claim 49 recites that the RSV be attenuated. Claims 50-52 incorporate the recitations of an attenuated RSV by virtue of their dependencies from claim 49.

**THE REJECTIONS UNDER 35 U.S.C. § 102 ARE OBLIGATED BY THE AMENDMENT MADE HEREIN AND SHOULD THEREFORE BE WITHDRAWN**

Claims 17-18, 22-32, and 35-40 were rejected under 35 U.S.C. 102(b) allegedly as being anticipated by Collins *et al.* (WO 97/12032; "Collins"). Further, claims 17-18, 22-32, and 35-40 were rejected under 35 U.S.C. 102(e) allegedly as being anticipated by Murphy *et al.* (U.S. Patent 5,993,824; "Murphy"). This rejection is in error and should be withdrawn. In response, Applicants assert that neither Collins nor Murphy are available as prior art against the present application because the earliest priority date of the present application predates both references as discussed above.

Collins became available as prior art under 35 U.S.C. 102(b) on April 3, 1997. The priority date of the instant application, as amended herein, is September 30, 1994 and predates Collins. Thus, Collins is not available as art to the instant application and Applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) should be withdrawn.

Murphy was filed on July 15, 1997 and appears to claim the benefit of priority of three provisional applications, the earliest of which was filed on July 15, 1996. The earliest possible 102(e) date of Murphy is therefore July 15, 1996. The priority date of the instant application, however, is September 30, 1994 and predates Murphy. Thus, Murphy is not available as art to the instant application and Applicants respectfully submit that the rejection under 35 U.S.C. § 102(e) should be withdrawn.

Claims 17-18, 22-32, and 35-40 were further rejected under 35 U.S.C. § 102 allegedly because the claims are not supported by the specification of the earliest priority application. Applicants respectfully disagree.

Without making any admissions and solely to expedite prosecution, however, Applicants have cancelled claims 1-48, in view of which, the rejection under 35 U.S.C. § 102 is moot. Applicants assert that the rejection for lack of support does also not apply to new claims 49-52. Support for the new claims can be found in the earliest priority document, issued as U.S. 5,840,520, as set forth in the chart in the Remarks section of the present response.

**THE REJECTIONS UNDER 35 U.S.C. § 103(a) IS OBLIVIATED BY THE AMENDMENT MADE HEREIN AND SHOULD THEREFORE BE WITHDRAWN**

Claims 17-18, 22-32, and 35-40 are rejected under 35 U.S.C. § 103(a) allegedly as being obvious over Collins *et al.*, 1995 (Proc. Natl. Acad. Sci. 92:11563-11567; "Collins, 1995") in view of Olmsted *et al.* (Proc. Natl. Acad. Sci. 83:7462-7466, 1986; "Olmsted"). This rejection is in error and should be withdrawn. In response, Applicants assert that the earliest priority date of the present application predates Collins and that the claims as pending are fully supported by the specification as filed in the earliest priority case of the present application.

Collins, 1995 became available as prior art for 35 U.S.C. 103(a) in December 1995. The priority date of the instant application, as amended herein, is September 30, 1994 (see above) and predates Collins, 1995. The rejection under 35 U.S.C. § 103(a) depends on the combination of Collins, 1995 with Olmsted. As Collins, 1995 is not available as prior art to the instant application, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

## **CONCLUSION**

Applicants respectfully request entry and consideration of the foregoing amendments and remarks. No new matter has been introduced. The claims are believed to be free of the art and patentable. Withdrawal of all the rejections and an allowance are earnestly sought.

Respectfully submitted,

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